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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/862,808	05/22/2001	Yijun Deng	ORT-1432	1171

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EXAMINER

BAKER, MAURIE GARCIA

ART UNIT PAPER NUMBER

1627

DATE MAILED: 08/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/862,808

Applicant
Deng et al

Examiner
Mauri Garcia Baker, Ph. D.

Art Unit
1627



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ONE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-30 are subject to restriction and/or election requirements.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

DETAILED ACTION

Please Note: In an effort to enhance communication with our customers and reduce processing time, Group 1627 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-308-4315. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-3, 21 and 22, drawn to a method of synthesizing highly substituted azole compounds having the general formula (Ia) {where Z is non-hydrogen}, classified in a wide variety of classes and subclasses depending on the ultimate structure of the compound made, for example, class 548, subclass 141.
 - II. Claim 4, drawn to a process for preparing a compound of general formula (Ia) {where Z is hydrogen}, classified in a wide variety of classes and subclasses depending on the ultimate structure of the compound made, for example, class 548, subclass 334.5.
 - III. Claims 5-7, 23 and 24, drawn to a method of synthesizing highly substituted azole compounds having the general formula (IIa) {where Z is non-hydrogen}, classified in a wide variety of classes and subclasses depending on the ultimate structure of the compound made, for example, class 548, subclass 259.
 - IV. Claim 8, drawn to a method of synthesizing highly substituted azole compounds having the general formula (IIa) {where Z is hydrogen}, classified in a wide variety of classes and subclasses depending on the ultimate structure of the compound made, for example, class 548, subclass 494.
 - V. Claim 9-11, 25 and 26, drawn to a method for preparing compounds of the formula (Ib), classified in a wide variety of classes and subclasses depending on the ultimate structure of the compound made, for example, class 548, subclass 339.1.

- VI. Claim 12-14, drawn to a method for preparing compounds of the formula (IIb), classified in a wide variety of classes and subclasses depending on the ultimate structure of the compound made, for example, class 548, subclass 492.
- VII. Claim 15, drawn to a chemical library comprising a plurality of substituted azole compounds prepared by the method of claim 1, classified variously depending on the ultimate structure of the compounds of the library, for example, class 548, subclass 141 or class 435, DIG 34.
- VIII. Claim 16, drawn to a chemical library comprising a plurality of substituted azole compounds prepared by the method of claim 4, classified variously depending on the ultimate structure of the compounds of the library, for example, class 548, subclass 334.5 or class 435, DIG 34.
- IX. Claim 17, drawn to a chemical library comprising a plurality of substituted azole compounds prepared by the method of claim 5, classified variously depending on the ultimate structure of the compounds of the library, for example, class 548, subclass 259 or class 435, DIG 34.
- X. Claim 18, drawn to a chemical library comprising a plurality of substituted azole compounds prepared by the method of claim 8, classified variously depending on the ultimate structure of the compounds of the library, for example, class 548, subclass 494 or class 435, DIG 34.
- XI. Claim 19, drawn to a chemical library comprising a plurality of substituted azole compounds prepared by the method of claim 9, classified variously depending on the ultimate structure of the compounds of the library, for example, class 548, subclass 339.1 or class 435, DIG 34.
- XII. Claim 20, drawn to a chemical library comprising a plurality of substituted azole compounds prepared by the method of claim 12, classified variously depending on the ultimate structure of the compounds of the library, for example, class 548, subclass 492 or class 435, DIG 34.
- XIII. Claim 27, drawn to a process for preparing a compound of general formula (Ic), classified in a wide variety of classes and subclasses depending on the ultimate structure of the compound made, for example, class 548, subclass 342.1.

XIV. Claim 28, drawn to a process for preparing a compound of general formula (IIc), classified in a wide variety of classes and subclasses depending on the ultimate structure of the compound made, for example, class 548, subclass 174.

XV. Claim 29, drawn to a process for preparing compounds of the formula (Id), classified in a wide variety of classes and subclasses depending on the ultimate structure of the compound made, for example, class 548, subclass 267.6.

XVI. Claim 30, drawn to a process for preparing compounds of the formula (IId), classified in a wide variety of classes and subclasses depending on the ultimate structure of the compound made, for example, class 548, subclass 304.1.

2. The inventions are distinct, each from the other because of the following reasons:

3. Groups I – VI and XIII – XVI are different methods. The methods are different because they use different steps, require different reagents and/or will produce different products/results. They therefore have different issues regarding patentability and enablement and represent patentably distinct subject matter. This is discussed in detail below.

4. In the instant case, each of the methods of making have completely different end results as the compound made by each method has a different structure. Furthermore, due to these differences in structure, each of the methods requires different reactants for making said compounds and comprise different reaction steps. Moreover, art anticipating one group would not anticipate the other groups due to the different compound structures that are made by each method and the different reactants/reaction steps.

5. Groups VII – XII represent separate and distinct products. They differ in respect to their properties, their use and the synthetic methodology for making them. Therefore, they have different issues regarding patentability and enablement and represent patentably distinct subject matter. In the instant case, the libraries of Groups VII – XII are each different products because the compounds of each library have *different structures*. See also paragraph 4 above.

6. Groups I – VI and XIII – XVI are not related to Groups VII – XII. The inventions are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects. In the instant case the libraries of Groups VII – XII are not related to the method of preparing *single compounds* of Groups I – VI and XIII – XVI. Libraries and single compounds have different uses and require different methods of making. However, if applicant argues that the claims are related as process of making and product made, the following is noted. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the libraries of Groups VII – XII could be made by a different process than the methods of Groups I – VI and XIII – XVI. For example, the libraries could be made on a solid support and cleaved therefrom.

7. These inventions have acquired a separate status in the art as shown by their different classification and/or divergent subject matter. The different inventions would

require completely different searches in both the patent and non-patent databases, and there is no expectation that the searches would be coextensive. Therefore, this does create an undue search burden, and restriction for examination purposes as indicated is proper.

8. This application contains claims directed to patentably distinct species of the claimed invention for **all of Groups I – XVI**. Election is required as follows.

9. If applicant elects the invention of **any of Groups I – VI or XIII – XVI**, applicant is required to elect from the following patentably distinct species. Specific species from *each* subgroup below should be elected. The first listed claim in each group above is generic to each group.

Species of compound made

A *specific* compound made by the claimed method should be elected, for purposes of search. The compound should have all variable groups specifically defined resulting in election of a single compound with all atoms and bonds shown.

Species of reactants

Each of the reactants required for the preparation of the compound elected above should also be *specifically* elected. Each reactant should have all variable groups specifically defined resulting in election of single reactant compounds with all atoms and bonds shown for each.

The species are distinct, each from the other, because their structures and modes of action are different. They would also differ in their reactivity and the starting materials from which they are made. Therefore, the species have different issues regarding patentability and represent patentably distinct subject matter.

10. If applicant elects the invention of *any of Groups VII – XII*, applicant is required to elect from the following patentably distinct species. The first listed claim in each group above is generic to each group.

Species of library

A *specific* library should be elected, for purposes of search. It is recognized that the claims are drawn to a library and not a single compound; however, the core of the library should be defined. The election should result in a specifically defined core compound that is common to all library members.

The species are distinct, each from the other, because their structures and modes of action are different. They would also differ in their reactivity and the starting materials from which they are made. Therefore, the species have different issues regarding patentability and represent patentably distinct subject matter.

11. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

12. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and *a listing of all claims readable thereon*, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

13. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims

are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

14. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

15. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143). Because the above restriction/election requirement is complex, a telephone call to applicants to request an oral election was not made. See MPEP § 812.01.

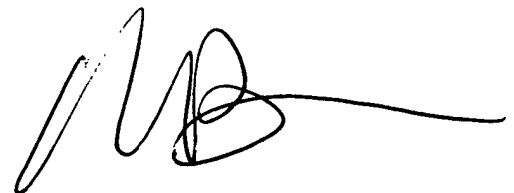
16. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

17. Applicant is also reminded that a 1 - month (not less than 30 days) shortened statutory period will be set for response when a written requirement is made without an action on the merits. This period may be extended under the provisions of 37 CFR 1.136(a). Such action will not be an "action on the merits" for purposes of the second action final program, see MPEP 809.02(a).

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maurie Garcia Baker, Ph.D. whose telephone number is (703) 308-0065. The examiner can normally be reached on Monday-Thursday from 9:00 to 6:30 and alternate Fridays.

19. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane, can be reached on (703) 308-4537. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Maurie Garcia Baker, Ph.D.
July 31, 2002

A handwritten signature in black ink, appearing to read 'MGB', with a long horizontal line extending to the right.

MAURIE GARCIA BAKER, Ph.D.
PATENT EXAMINER



RESTRICTION ELECTION FACSIMILE TRANSMISSION

DATE:

FROM/ATTORNEY:

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PAGES, INCLUDING COVERSHEET:

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TO EXAMINER: Maurie Garcia Baker, Ph.D.

ART UNIT: 1627

SERIAL NUMBER:

FAX/TELECOPIER NUMBER: (703) 308-4315

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